

FROM : Francis L. Conte, Esq.
PATENT
Docket 13DV-14194

FAX NO. : 781 592 4618

Aug. 08 2003 10:43AM P8/14

REMARKS

Reconsideration of the above identified application is respectfully requested.

Applicants traverse the rejection of claims 1-10 under Section 102(e) over Reichelt et al.

The examiner's contentions fail to address the specificity of Applicants' claims, and fail to address the specificity of the applied reference. The examiner's contention to "see the entire document" does not support the omnibus rejection of claims 1-10; nor does the examiner's mere contention of "permissible inclusion of cellulose fibers...."

The "entire document" is like a dictionary of chemical constituents in which many, many constituents are listed for breadth; yet at the same time the "entire document" also recognizes the corresponding differences in possible final products from different combinations of those constituents.

See, for example only, col. 9, ll. 61+, which states that "it is also possible to use mixtures of polyols for producing flexible or rigid foams." And, of course, flexible and rigid foams could not be any more different from each other.

So where in Reichelt is any teaching of a specific combination of constituents like those recited in claims 1-10 having the attributes therefor as disclosed in Applicants' specification?

It appears that the examiner has uncovered the two similar references now being applied based on a mere computer search for "cellulose fibers," yet this is insufficient to support a rejection under Section 102, especially in this chemical art wherein the products produced are quite different from each other depending upon their chemical composition, and method of manufacture.

See paras. 33 and 34 of Applicants' specification which well recognizes the conventionality of producing sponge material, yet having properties which can vary quite significantly.

See also the many examples presented in Reichelt, yet none of

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those examples appears anticipatory of claims 1-10.

Instead, the examiner relies on the "permissible inclusion of cellulose fibers;" in what combination?

At col. 12 of Reichelt a substantial list of fillers is presented; but there is no teaching of how any one of those fillers would be used in any one combination with the prepolymers being taught by Reichelt. Which example includes "cellulose fibers?"

Col. 12 of Reichelt expressly teaches that "fillers, in particular reinforcing fillers, are the customary organic and inorganic fillers ... for improving the abrasion behavior in paints, coatings, etc." Yet, Applicants' claims 1-10 are not "paints or coatings."

Col. 12 at lines 25+, also teach "matts, nonwovens and woven fabrics" for the "cellulose fibers," yet these are not relevant to Applicants' claims either.

The examiner's mere finding of "cellulose fiber" in this reference does not support the different compositions recited in claims 1-10 being rejected. "Permissible inclusion" is not the same as an anticipation which requires identity of constituents, not shown by the examiner.

It has been held that anticipation cannot be made on mere conjecture (*W.L. Gore & Associates, Inc., v Garlock, Inc.*, 220 USPQ 303, 314, Fed. Cir., 1983, cert. denied, 469 U.S. 851 (1984)). Furthermore, it is stated in *General Tire & Rubber Co. v Firestone Tire Co.*, 174 USPQ 427, 442-443, D.Ct., Ohio, 1972, affirmed in part, 180 USPQ 98, Ct. Ap., 6th Cir., 1973, that:

"The standards of anticipation are strict. The invention must be disclosed within the four corners of a single reference. If a reference is silent or ambiguous with respect to an element of the invention, that gap cannot be filled by assumption or by combining one reference with another. An anticipating reference must teach the invention; it is not sufficient to point to its silence or ambiguity after the invention and argue that the invention could be made out from reference."

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Where does Reichelt teach the various combinations of claims 1-10?

Furthermore, in *In re Felton*, 179 USPQ 295 (CCPA, 1973) the CCPA indicated that:

...in view of the purpose for which the Sands' device is intended, it is apparent that it requires no critical dimension which would lead to a structure inherently having those characteristics. Therefore, it would be mere happenstance if any structure according to Sands met the limitations of the claims. An accidental or unwitting duplication of an invention cannot constitute an anticipation [citations omitted]. For this reason, we do not believe that Sands has "identically disclosed or described" the invention as required of an anticipatory reference applied under section 102. The disclosure as a whole cannot be considered to sufficiently direct one skilled in the art to the invention which is a single drop dispenser requiring critical dimensions.

The "dictionary" listing of a myriad of constituents in Reichelt clearly does not anticipate all possible combinations thereof. It would be mere happenstance if any combination possible in Reichelt would include cellulose fibers in the combinations recited in claims 1-10 being rejected.

Claim 1 expressly recites a polymeric sponge including cellulose fibers imbedded therein.

Where in Reichelt is a teaching that the cellulose fibers listed at col. 12 for "paints, coatings, matts, nonwovens and woven fabrics" are imbedded in a polymeric sponge in Reichelt?

Where does Reichelt teach the species of claim 2-5 for example?

Claim 6 recites "closed cells" for particular advantage as disclosed in the specification, and in contrast with open cells. Where does Reichelt disclose or suggest closed cells in combination with cellulose fibers?

Claim 7 specifically excludes surfactants; yet at col. 11, lines 46+, Reichelt discloses "surfactants" (See also col. 9 of similar reference Keppeler).

Similarly, claim 9 specifically excludes bonding agent; yet where is this disclosed in any combination in Reichelt?

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Accordingly, withdrawal of the omnibus rejection of claims 1-10 under Section 102(e) over Reichelt et al is warranted and is requested.

Applicants traverse the rejection of claims 1-10 under Section 102(b) over Keppeler et al.

Note the common disclosures of this reference with Reichelt, both assigned to BASF, with the common inventor Reichelt.

Note the examiner's mere verbatim repetition of contentions for the two rejections under Sections 102(e) and (b).

As indicated above, the examiner has failed to establish prima facie anticipation under Keppeler for the same reasons presented above for Reichelt.

Note how the use of Keppeler further teaches away from Applicants' invention. Keppeler clearly includes the many, many constituents like those in Reichelt, and now emphasizes the use of those constituents in producing "rigid, isocyanate-based foams," having no relevance to the pliant sponge being recited in Applicants' claims, and disclosed in the specification.

The examiner's use of the "cellulose fibers" found at col. 9 of Keppeler is now specifically relevant only to the rigid foams disclosed in Keppeler, rendering the differences with Applicants' invention even greater.

Accordingly, withdrawal of the omnibus rejection of claims 1-10 under Section 102(b) over Keppeler et al is warranted and is requested.

Notwithstanding the above traverse, the claims are nevertheless being amended in view of the already allowed claims, to further distinguish over the newly applied references in an attempt to promptly terminate the prosecution of this application.

Although the examiner has already allowed the claims listed at box 5, claims 11, 12, 16, and 22 are being amended into independent form since they originally depended from claims still being rejected.

Accordingly, the list of claims at box 5 should now be properly allowed.

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Independent claim 1 has been amended to recite the granular nature of the polymeric sponge, with the granules being pliant and cellular as disclosed at paras. 15, 19, and 32, for example.

There appears to be no teaching in Reichelt and Keppeler that the foam products thereof are granules.

Although Reichelt teaches both rigid and flexible foams, there appears to be no teaching of pliant cellular granules with imbedded cellulose fibers.

And, Keppeler clearly teaches rigid foams, irrespective of the cellulose fibers therein.

Accordingly, claims 1-10 should now be well distinguishable over Reichelt and Keppeler.

It is noted that despite the listing of claims at box 6, only claims 1-10 have been in fact rejected, and claims 13-15 and 19-21 have not been rejected for any identified cause.

Accordingly, the rejection of claims 13-15 and 19-21 is void ab initio for lacking any basis under the statute and rules.

Nevertheless, claims 13-15 depend from amended claim 1, and are additionally distinguishable over Reichelt and Keppeler for their specific combinations having no counterpart in these references. And, independent claim 19 has been similarly amended to recite the pliant granular form of the sponge having the cellulose fibers therein, with neither Reichelt nor Keppeler disclosing this specific combination.

In accordance with the duty imposed by 37 CFR 1.104 and MPEP sections 707, 707.05, 707.07, and 707.07(g), the examiner is requested to reconsider all the art of record, to ensure full compliance with the required thoroughness of examination.

In re Portola Packaging, Inc., 42 USPQ2d 1295 (Fed. Cir. 1997) emphasizes the importance of complying with this duty to ensure that all references of record have been fully considered by the examiner in the various combinations thereof. And, the Board of Appeals has further elaborated on the importance of this examiner duty in Ex parte Schricker, 56 USPQ2d 1723 (B.P.A.I. 2000).

In view of the above remarks, allowance of all claims 1-43 over

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the art of record is warranted and is requested.

In the spirit of cooperation offered by the examiner to conduct a phone interview, this attorney would welcome a phone call from the examiner to address any final issues that might remain.

Since all product-by-process claims 23-43 have been allowed, corresponding product claims are also warranted, and the above amendment of independent claims 1 and 19 is being made to promote the early termination of prosecution.

Please charge the required fee for the introduction of the four additional independent claims 11, 12, 16, and 22, and any deficiency associated with this amendment, to Deposit Account No. 07-0865 of General Electric Company in accordance with attached Fee Transmittal for FY 2003.

Respectfully submitted,



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Date: 8 AUG 2003

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Attachment: One-page Fee Transmittal for FY 2003